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10/662,644	01/22/08	Mayer, Victor	214,68	LEYDIG VOLK & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6780

APPLICANT'S ATTORNEY OR AGENT

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EXAMINER

GILLIAM, BARBARA LEE

ARTICLE NUMBER

PAPER NUMBER

DATE MAILED: 06/03/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/002,944

Applicant(s)

VAN DAMME ET AL

Examiner

Barbara Gilliam

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

By law, a shortened statutory period for reply is set to expire two months from the mailing date of this communication. If the period for reply is set to expire less than two months from the mailing date, or if there is no mailing date, the period for reply is set to expire six months from the mailing date of this communication. Failure to reply within the set extended period for reply will result in a statute of bars against the application. See 35 U.S.C. § 133 and 37 CFR 1.46. Payment of issue fee within three months after the mailing date of this communication will eliminate the statute of bars. See 37 CFR 1.48.

### Status

1) Responsive to communication(s) filed on amendment filed 3/7/03.

2a) This action is FINAL                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s)        is/are withdrawn from consideration.

5) Claim(s)        is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s)        is/are objected to.

8) Claim(s)        are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on        is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on        is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1) Certified copies of the priority documents have been received.  
2) Certified copies of the priority documents have been received in Application No.       .  
3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) A copy of the application is enclosed in Exhibit A.  
2) A copy of the application is enclosed in Exhibit B, page 137, line 44.  
3) A copy of the application is enclosed in Exhibit C, page 141.

4) A copy of the application is enclosed in Exhibit D, page 142.  
5) A copy of the application is enclosed in Exhibit E, page 143.  
6) A copy of the application is enclosed in Exhibit F, page 144.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed March 7, 2003 has been considered.
2. The 35 USC 112, 2<sup>nd</sup> paragraph rejection of claim 2 is withdrawn.
3. Claims 1-10 are pending.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 4-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by DeBoer.

a. In WO 99 19143, DeBoer teaches a lithographic plate made by coating a support web with a coextensive ink receptive photothermal conversion layer and then overcoating with an ink repellent layer comprising a cross-linked polymeric matrix containing a colloid of an oxide or a hydroxide of a metal selected from the group consisting of beryllium, magnesium, aluminum, silicon, gadolinium, germanium, arsenic, indium, tin, antimony, tellurium, lead, bismuth, a transition metal and combinations thereof, along with a photothermal conversion material (abstract). The photothermal layer comprises a photothermal conversion material such as a dye or pigment and a binder such as nitrocellulose (page 6, line 13-page 7, line 15). The

photothermal layer meets the present limitation for the oleophilic imaging layer. In Example 5, a grained and anodized aluminum support was coated with a photothermal layer and a crosslinked layer comprising a carbon dispersion wherein the carbon is modified with sulfonic acid at the surface. The sulfonic acid surface modified carbon meets the present limitations for the organic compound of formula (II). The top layer meets the present limitations for the crosslinked upper layer. The resulting plate was then exposed to a focused diode laser beam with an intensity of 3 mW/m<sup>2</sup>. After exposure the plate was directly mounted on a printing press and impressions were made (page 12, line 26 – page 13, line 6 & page 11, line 18). The process for using the resulting lithographic plate comprises the steps of exposing the plate to a focused laser beam in the areas where ink is desired in the printing image and employing the plate on a conventional lithographic printing press (page 9, line 32 – page 10, line 1). Therefore the plate is negative working.

b. With respect to claim 2, Applicant is reminded of MPEP 2113: "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 772 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The Cabojet 200 of DeBoer (WO 99/19143) meets the present limitations for the organic compound of formula (II).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBoer in view of Van Damme et al.

a. As indicated in the corresponding 35 U.S.C. 102(b) rejection above, DeBoer teaches a lithographic plate made by coating a support web with a coextensive ink receptive photothermal conversion layer and then overcoating with an ink repellant layer comprising a cross-linked polymeric matrix containing a colloid of an oxide or a hydroxide of a metal wherein the ink repellant layer comprises a dispersion of sulfonic acid surface modified carbon. DeBoer does not teach the thickness of the photothermal layer or the top melanophobic layer however, it would have been obvious to coat each of the layers at a thickness consistent with similar layers in the printing plate art. In US Patent No. 6,399,276, Van Damme et al teach a processless printing plate comprising in the order given on a support an IR-sensitive oleophilic layer and a crosslinked hydrophilic layer (abstract). The oleophilic layer is coated at a dry weight of from 0.5 to 30 g. m<sup>-2</sup> (column 5, lines 8-9). The crosslinked hydrophilic layer of Van Damme et al preferably also contains particles of oxides or hydroxides to increase mechanical strength and porosity of the layer. Van Damme et al teach coating the crosslinked layer at a thickness of 0.3 to 5 μm (column 4, lines 4-38).

b. Therefore it would have been obvious to one of ordinary skill in the art to make and expose a lithographic plate comprising a grained and anodized aluminum support, a photothermal layer having a coating weight of 0.5 to 30 g/m<sup>2</sup> and a crosslinked layer having a thickness of 0.3 to 5 µm based on the teachings of Van Damme et al without chemical processing.

### ***Response to Arguments***

8. Applicant's arguments filed March 7, 2003 have been fully considered but they are not persuasive.

a. Applicant argued one of ordinary skill in the art would readily appreciate that the carbon discussed in DeBoer (WO 99/19143) does not constitute a macromolecular organic radical. Applicant further argued that DeBoer does not characterize carbon as a macromolecular organic radical and characterizes carbon as a pigment. Applicant points to DeBoer page 9, lines 15-16 as support. The Examiner disagrees. According to the CONCISE CHEMICAL and TECHNICAL DICTIONARY, 2<sup>nd</sup> Ed., Chemical Publishing Co., Inc (1962), macromolecule is defined "as a giant molecule of very great length; equal in size to that of a colloidal particle" (page 572). At page 234, colloidal carbon is defined as "carbon black" and at page 178 under carbon black, reference is made to "gas black." At page 424, gas black is defined as "(carbon black), fluffy black pigment produced by the incomplete combustion of natural gases; used in printers' ink, . . . , etc." Therefore in light of the definitions provided above, the Examiner asserts the sulfonic acid surface modified submicron carbon dispersion of DeBoer meets the present limitations for the organic compound of formula (II) wherein

the carbon black meets the present limitations for R2 because carbon black is colloidal and therefore equal in size to that of a macromolecule. Further Carbon is an organic element and organic chemistry is the study of carbon compounds.

b. Applicant argued Van Damme et al. (US 6,399,276 B1), prior art under 35 USC §102(e), is commonly owned with the present application and may not be used to set forth an obviousness rejection under 35 USC §103(a) because of 35 USC §103(c). Applicant is reminded of the exact language of 35 USC §103(c): "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Applicant has not stated that the inventions were commonly owned at the time of invention. See also MPEP 706.02(l)(2) and 706.02(l)(3) [R-1].

c. A copy of page 659 of HACKH'S CHEMICAL DICTIONARY, 3<sup>RD</sup> Ed. was not provided as indicated in the response.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 703-305-1330. The examiner can normally be reached on Monday through Friday, 8:00 AM - 6:00 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

b. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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*B. Gilliam*

B. Gilliam  
May 28, 2003